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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,905	01/31/2001	Kosuke Haruki	04329.2502	1103

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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP
1300 I STREET, NW
WASHINGTON, DC 20005

EXAMINER

KANG, INSUN

ART UNIT PAPER NUMBER

2124

DATE MAILED: 01/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/772,905

Applicant(s)

HARUKI, KOSUKE

Examiner

Insun Kang

Art Unit

2124

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2001 and 22 February 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☒ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-11 are pending.
2. The IDS dated 1/31/2001 has been considered.

Claim Objections

3. Claims 1, 3, 4 are objected to because of the following informalities: the claims contain a phrase "a secret area" which is not stated in a concise term. It is interpreted as an "internal memory." Appropriate correction is required.
4. Claim 4 is objected to because of the following informalities: the claim contains a word "prepared" in line 9 which is not stated in an exact term. It is interpreted as "stored." Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Story, Jr. et al. (US Pub. No. 2002/0046181), hereinafter referred to as "Story."

As per claim 8, Story discloses *an electronic device capable of recording or playing back contents downloaded from a computer, comprising means for storing license data necessary for installing software for contents transfer from the computer to a contents playback device, or executing a specific function of the software, and management data for managing an issue history of the license data* ("A method and apparatus for digital content license management is disclosed that provides one or more license management devices that manage licenses for playback of digital content," abstract; "Playback device interface 130 allows computer system 100 to communicate licensing information, digital content, and other data to and receive data from a mobile playback device," pg 2, paragraph 0021-22; "Player 400 is a mobile playback device that allows digital content to be downloaded, for example, via a playback device interface a played back later. A user can utilize the buttons on player 400 to navigate through stored data to replay desired digital content," Pg 2, paragraph 0031; see also pg 2, paragraph 0021); *means for, upon reception of a license data acquisition request from a computer connected to the contents playback device, determining permission or inhibition of issuing the license data for the acquisition request on the basis of the management data* ("one or more license management devices that manage licenses for playback of digital content. The license management devices create licenses having an associated cardinality that determines the number of playback devices that can be authorized by the license. The license is stored in a set of playback devices, where the number of playback devices in the set is less than or equal to the cardinality of the license," pg 1, paragraph 0016; The license is stored in a



set of one or more playback devices at 630... the license management device issues a command to one or more specific playback devices. The command includes a player identifier for each of the one or more players targeted and is encrypted and digitally signed by the license management device. The license is stored in the playback device if the command originates from an authorized source and includes the identifier of the playback device. Alternatively, the license can be stored in the set of playback devices in another manner," pg 4, paragraph 0050; see also abstract; pg 3, paragraph 0043; Fig 6).

As per claim 9, the rejection of claim 8 is incorporated, Story further discloses *returning a content of the management data to a state preceding issue of the license data in response to an uninstall notification of the software that is issued from the computer to the electronic device* ("In one embodiment license management device 510 is necessary to either add or remove licenses from a playback device. Thus, license management device 510 can be used to provide centralized license management," pg 4, paragraph 0047).

As per claim 1, it is the license management method version of claim 8, respectively, and is rejected for the same reasons set forth in connection with the rejection of 8 above.

As per claim 2, the rejection of claim 1 is incorporated, Story further discloses

the control step controls to issue the license data to the computer when the determination result indicates that the license data has not been issued, and to inhibit the issuance of the license data when the determination result indicates that the license data has been issued ("When a playback device receives digital content, the playback device checks the digital content for a license that matches the license stored in the playback device. If the licenses match, the playback device is authorized to, and is enabled to, play the digital content, which includes decrypting the digital content if necessary. Otherwise the playback device does not play the digital content," pg 3, paragraphs 0041 and 0042; Fig 6).

As per claim 3, the rejection of claim 1 is incorporated, Story further discloses *ID data for identifying a computer which has issued the license data is registered as the management data in the secret area, and permission or inhibition of issuing the license data for the acquisition request is determined by the controller of the electronic device, on the basis of whether the ID data has not been registered and whether the ID data is coincident with ID data of the computer which has issued the acquisition request* ("In one embodiment, the license comprises a 32 bit group identifier... Thus, each playback device storing a license belongs to a set of one or more playback devices storing the license. The set of playback devices is authorized to play digital content that includes the license," pg 3, paragraph 0043, see also pg 2, paragraphs 0027, 0041, 0042 and 0050).

As per claim 4, the rejection of claim 1 is incorporated, Story further discloses a *plurality of memory areas for registering a plurality of ID data are prepared in the secret area* ("Playback devices can store multiple licenses, which allows playback devices to belong to multiple sets of playback devices authorized to playback various digital content," pg 2, paragraphs 0032; " The license is stored in a set of one or more playback devices at 630... the license management device issues a command to one or more specific playback devices. The command includes a player identifier for each of the one or more players targeted and is encrypted and digitally signed by the license management device. The license is stored in the playback device if the command originates from an authorized source and includes the identifier of the playback device. Alternatively, the license can be stored in the set of playback devices in another manner," pg 4, paragraph 0050).

re As per claim 5, ~~the rejection of claim 1 is incorporated,~~ it is the license management method version of claim 9, respectively, and is rejected for the same reasons set forth in connection with the rejection of 9 above.

As per claim 6, the rejection of claim 1 is incorporated, Story further discloses *the electronic device includes a contents playback device for recording and playing back contents transferred from the computer, and the software has a function of managing contents transfer to the electronic device* ("The present invention relates to digital information playback. More particularly, the present invention relates to

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management of licenses for playback of digital information,” pg 1, paragraph 0001; “ In one embodiment, the present invention is related to the use of computer system 100 to provide, manage and/or receive licenses for digital content playback devices,” pg 1, paragraph 0022; “Software players are software entities executed by computer systems that use the computer system memory to store the digital content and the computer system A/V capabilities to play the digital content,” pg 1, paragraph 0003).

As per claim 7, the rejection of claim 6 is incorporated. Story further discloses *the software uses license data in the electronic device to perform authentication of whether the electronic device is rightful, and when authentication succeeds, transfers contents to the electronic device* (“Playback devices that have a license that matches a license included in the digital content are authorized to play the digital content. In one embodiment a single license can be used to provide authorization to play digital content from multiple sources and/or multiple types of content. Playback devices can store multiple licenses, which allows playback devices to belong to multiple sets of playback devices authorized to playback various digital content,” pg 1, paragraph 0017; “The license is also communicated to content provider 520 by license management device 510. In one embodiment content provider 520 embeds the license in digital content for which the owner of the playback device is authorized to play,” pg 4, paragraph 0050; “When a playback device receives digital content, the playback device checks the digital content for a license that matches the license stored in the playback device. If the licenses match, the playback device is authorized to, and is enabled to,

play the digital content, which includes decrypting the digital content if necessary. Otherwise the playback device does not play the digital content," pg 3, paragraph 0041).

As per claim 10, it is the computer-readable recording medium version of claim 8, respectively, and is rejected for the same reasons set forth in connection with the rejection of 8 above.

As per claim 11, it is the method version for a contents playback device of claim 8, respectively, and is rejected for the same reasons set forth in connection with the rejection of 8 above.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Insun Kang whose telephone number is 703-305-6465. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on 703-305-9662. The fax phone number for the organization where this application or proceeding is assigned is 703-308-3988.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

IK
1/21/2004


KAKALI CHAKI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100